

REMARKS

Reconsideration of this application, based on this amendment and these following remarks, is respectfully requested.

Claims 1 through 6, 9, 11, 20 through 30, and 33 through remain in this case. Claim 8 is proposed to be canceled. Claims 1 through 6, 9, 11, 20 through 25, 29, and 33 are proposed to be amended.

The Examiner objected to the Abstract of the Disclosure. A revised Abstract of the Disclosure is presented in this paper, correcting the noted informality.

Claim 1 and its dependent claims 2 through 6, 8, 9, 11, and 20 through 22, were finally rejected under §112, ¶2, as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner asserted that the determining step of claim 1 appeared to include a plurality of data processors in the system, but that only "a data processor in the system" is disclosed.¹

Claim 1 is proposed to be amended to clarify its patentability over the prior art, as will be discussed below. This proposed amendment does not affect the §112 issue, however.

Accordingly, Applicant respectfully traverses the §112 rejection of claim 1 and its dependent claims, on the grounds that claim 1 reads on both a system that includes one data processor, and also on a system that includes a plurality of data processors. If one considers a system with one data processor, it is not difficult to read both the step of "determining whether a data processor in the system satisfies the at least one platform requirement for the retrieved program" and also the step of "responsive to the determining step, downloading the program to the data processor that satisfies the at least one platform requirement". Conversely, each of the steps of "determining whether a data processor in the system satisfies the at least one platform requirement for the retrieved program" and "responsive to the determining step,

downloading the program to the data processor that satisfies the at least one platform requirement" can clearly be read on a system having multiple data processors.

Applicant therefore respectfully submits that claim 1 is generic to both a single data processor system and also to a system having multiple data processors. The claim can clearly be read on either case, with no confusion resulting. Accordingly, Applicant respectfully submits that claim 1 is sufficiently definite as to meet the requirements of §112, ¶2, and therefore respectfully traverses this basis of rejection.

The undersigned is willing to entertain suggestions from the Examiner that are considered to address this issue, so long as such suggestions do not narrow the scope of the invention as claimed.

Claims 1 through 4, 6, 8, 9, 11, 21 through 23, 28, 29, and 33 were finally rejected under §103 as unpatentable over the Halpern et al. reference² in view of the Suzuki reference³. The Examiner asserted that the Halpern et al. reference teaches (expressly or inherently) a method of downloading a program to a data processor, in which the program is in an executable file along with information "indicating a condition".⁴ The Examiner admitted that the Halpern et al. reference does not explicitly teach the step of downloading the program responsive to a determining step, but submitted that the downloading of a program after a determination is inherent in the Halpern et al. teachings, considering that the receiving processor must be capable of receiving the program.⁵ The Examiner further asserted that the abstract of the Suzuki reference teaches a file management system in which "predetermined conditions" are performed.⁶ The Examiner therefore concluded that one skilled in the art would be motivated to modify the Halpern et al. teachings to include "predetermined conditions" that allow

¹ Office Action of February 13, 2004, pp. 2 and 3.

² U.S. Patent No. 6,282,711 B2, issued August 28, 2001 to Halpern et al., from an application filed August 10, 1999.

³ Japanese Patent Publication 11-203187, published July 30, 1999, naming Hideo Suzuki as the inventor.

⁴ Office Action, *supra*, ¶ 8, pp. 3 and 4.

⁵ *Id.*, at page 4.

⁶ *Id.*

"efficiency of operation" in different environments.⁷ Claim 8 (the additional limitation of which is now pertinent to proposed amended claim 1) was further rejected because the Examiner found that the Halpern et al. reference teaches providing "required (necessary)" information for the program,⁸ thus presumably meeting the requirement of "information indicative of a data processor platform requirement of said program" as claimed.

Claim 5 was finally rejected under §103 as unpatentable over the Halpern et al. and Suzuki references, further in view of the Carron et al. reference.⁹ Claims 25 through 27 and 30 were finally rejected under §103 as unpatentable over the Halpern et al. and Suzuki references, further in view of the admitted prior art. Claim 20 was finally rejected under §103 as unpatentable over the Halpern et al. and Suzuki references, further in view of the Tevarian et al. reference.¹⁰

Amendment to claim 1 is presented above, to clarify the patentable distinction in the claims. This amendment should not be interpreted as acquiescing in the rejection, but is intended to advance the prosecution of this case by clarifying the patentability of the claim over the applied references.

Amended claim 1 now recites that the providing step provides the program in an executable file together with non-program information that comprises at least one platform requirement for execution of the program. The determining step now determines whether a data processor in the system satisfies the at least one platform requirement for the retrieved program, with the downloading step being performed responsive to the determining step. Support for this amendment to claim 1 is present in the specification of this application¹¹, and therefore no new matter is presented by this amendment.

⁷ *Id.*

⁸ *Id.*, page 5.

⁹ U.S. Patent No. 4,724,521, issued February 9, 1988, to Carron et al.

¹⁰ U.S. Patent No. 5,604,905, issued February 18, 1997, to Tevarian et al.

¹¹ Specification of S.N. 09/822,753, filed March 30, 2001, at page 2, lines 13 and 14; at page 5, line 21 through page 6, line 3; at page 9, lines 17 through 21; at page 10, lines 8 through 11.

As previously argued, the method of proposed amended claim 1 provides important advantages in the management of co-processors in multi-processor systems.¹² By providing condition information within an executable file containing the program itself, auxiliary data sources (e.g., SQL engine, Microsoft registry, auxiliary text files) are not necessary, and the handling of such files is avoided.¹³ In addition, a host processor operating according to this invention can ensure that a co-processor is capable of executing the program prior to the download of the program to the co-processor¹⁴, and can also select the optimum co-processor in the system for the program if more than one is available¹⁵. Additionally, the method of proposed amended claim 1 avoids the need for separate APIs for multiple operating systems¹⁶, and is sufficiently efficient that it can be used in single-chip systems¹⁷.

Claims 2 through 6, 9, 11, and 20 through 22 are proposed to be amended for consistency with the proposed amendment to claim 1, upon which they depend, and for clarity. Claim 8 is proposed to be canceled, considering the proposed amendment to claim 1.

Applicant respectfully submits that amended claim 1 and its dependent claims are patentably distinct over the Halpern et al. and Suzuki references, because the combined teachings of these references fail to teach the step of determining of whether a data processor in a system satisfies platform requirements that are provided in an executable file along with the program itself, much less then downloading the program to the data processor responsive to this determining step, as required by proposed amended claim 1.

As previously argued, the Halpern et al. reference discloses the custom building of a software installation package based on user inputs from a client system, and then sending the customized installation package to the client system.¹⁸ In other words, the Halpern et al. reference teaches the providing of an executable file *after* information regarding the eventual

¹² Specification, *supra*, page 11, lines 6 through 19.

¹³ Specification, *supra*, page 3, lines 3 through 8.

¹⁴ Specification, *supra*, page 9, lines 17 through 21.

¹⁵ Specification, *supra*, page 6, lines 3 through 6.

¹⁶ Specification, *supra*, Figure 8.

¹⁷ Specification, *supra*, page 1, line 15 through page 2, line 2.

¹⁸ Halpern et al., *supra*, column 4, line 44 through column 6, line 19.

data processor is gathered and analyzed. The Halpern et al. reference therefore necessarily fails to disclose the determining of whether a data processor satisfies at least one platform requirement for a retrieved program, as required by proposed amended claim 1. The Suzuki reference (English language abstract) fails to add any teachings in this regard. Rather, the Suzuki reference appears to teach only the storing of state attributes (such as the presence or absence of downloading, uploading, or changes to the file); certain prescribed conditions relating to these attributes apparently control whether the files are uploaded to another computer.¹⁹ But nowhere does the Suzuki reference anywhere disclose the downloading of a program in response to a determination whether a data processor satisfies a platform requirement indicated in information included with the executable file of the program, as required by proposed amended claim 1. The other references of record in this case also lack teachings in this regard. Accordingly, Applicant respectfully submits that the combined teachings of the references fall short of the requirements of amended claim 1, if amended as presented above.

Applicant further respectfully submits that there is no suggestion from the prior art or otherwise to modify these teachings in such a manner as to reach the requirements of proposed amended claim 1. This lack of suggestion is especially apparent when one considers the purpose and intent of the Halpern et al. teachings, which are directed to the generation of a custom installation package for a client system, based on inputs from the user. The purpose of the Halpern et al. system is to avoid downloading software components that are not desired or necessary for the user's system. In other words, the purpose of the Halpern et al. system (to avoid downloading components that are unnecessary for the client's system) is opposite to that of the method of proposed amended claim 1 (to download the program to a data processor only after determining that the data processor satisfies platform requirements of the program). The Examiner's assertion regarding the word "required" in the sentence "[t]his is no bigger or smaller than what is absolutely required by the components and options selected"²⁰ ironically points out this very distinction. According to the Halpern et al. reference, the word "required"

¹⁹ Suzuki, *supra*, English language abstract.

²⁰ Halpern et al., *supra*, Abstract, lines 19 through 21, cited in Office Action, *supra*, ¶7.

refers to the paring down of the installation package to only those program components that are *required by the receiving system*; in contrast, according to proposed amended claim 1, the determining step determines whether the receiving data processor meets the *requirements of the program*, prior to downloading the program. The Suzuki et al. reference and the other references provide no teaching regarding this distinction of requirements between the Halpern et al. reference and those of the claim.

Accordingly, if the skilled artisan were to refrain from applying Applicant's own teachings in hindsight, as is proper for the obviousness determination,²¹ there is no way in which that person could combine the Halpern et al. and Suzuki references, and modify this combination, in such a manner as to reach the method of proposed amended claim 1. There is simply no suggestion from the prior art to change the Halpern et al. methodology from selecting and downloading only those software components useful for or desired by a particular destination client system, to determining whether platform requirements associated with a program are met by a data processor and then downloading the program to that data processor, as claimed.

Applicant therefore respectfully submits that, upon entry of this amendment, amended claim 1 and its dependent claims will be patentably distinct over the applied references.

Proposed amended claim 3 further requires, relative to proposed amended claim 1 upon which it depends, the step of selecting a data processor from a plurality of data processors in the system, using the at least one platform requirement. The Examiner admitted that there is no teaching in the cited prior art of the selecting of a data processor using "condition information"²², much less the platform requirement now recited in proposed amended claim 3. Applicant further respectfully submits that the assertion by the Examiner that one would have been motivated to "state that a processor is selected as part of the method disclosed by Halpern et al." is neither supported by any reasonable interpretation of the Halpern et al. reference, nor

²¹ See, e.g., *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

²² Office Action, *supra*, page 4.

rendered obvious by any of the other prior art of record in this case. For this additional reason, Applicant respectfully submits that proposed amended claim 3 is further patentably distinct over the prior art of record in this case.

For these reasons, among others, Applicant submits that proposed amended claim 1 and its dependent claims are patentably distinct over the prior art of record in this case. Entry of this amendment, and favorable reconsideration of these claims based on this amendment and these remarks, are respectfully requested.

Amendment is proposed to independent apparatus claim 23 in similar fashion. Proposed amended claim 23 now recites that the file storage facility includes an executable file containing a program and also non-program information comprised of at least one platform requirement for execution of the program. The claimed apparatus now also requires a first data processor that is programmed to perform a sequence of operations, comprising obtaining the program and non-program information from the file storage facility, determining whether a second data processor satisfies the at least one platform requirement, and responsive to determining that this second data processor satisfies the requirement, then downloading the program to the second data processor.

Independent claim 24 is proposed to be similarly amended as proposed amended claim 23. As before, the apparatus of claim 24 includes the second data processor.

Claim 25 is proposed to be amended to correct its punctuation. Claims 29 and 33 are proposed to be amended for consistency with proposed amended claim 24, upon which they depend.

Applicant respectfully submits that proposed amended claims 23, 24, and the claims dependent on claim 24, are patentably distinct over the applied references, on similar grounds as discussed above relative to proposed amended claim 1.

As previously argued, the Halpern et al. reference fails to disclose the determining of whether a second data processor satisfies at least one platform requirement for a retrieved

program, where the at least one platform requirement comprises non-program information that is contained in an executable file at a file storage facility, along with the program itself. Instead, the Halpern et al. reference teaches the construction of a downloadable software package in response to user inputs. There is no determination, according to the Halpern et al. reference, of whether any data processor satisfies platform requirements, much less the deciding of whether downloading operation is performed based on such a determination. As discussed above, the Suzuki reference (English language abstract) lacks teachings in this regard, instead apparently disclosing only the storing of certain state attributes (such as the presence or absence of downloading, uploading, or changes to the file) that apparently control whether the files are uploaded to another computer.²³ The Suzuki reference lacks any teaching regarding the downloading of a program in response to a determination, by a first data processor, of whether a second data processor satisfies a platform requirement indicated in information included with the executable file of the program. The other references of record in this case also lack teachings in this regard. Accordingly, Applicant respectfully submits that the combined teachings of the references fall short of the requirements of amended claims 23 and 24, if amended as presented above.

Applicant further respectfully submits that there is no suggestion from the prior art or otherwise to modify these teachings in such a manner as to reach the requirements of these claims. As discussed above, the Halpern et al. teachings are directed to the generation of a custom installation package for a client system, based on inputs from the user, to eliminate unusable or undesired software components from being downloaded. The Halpern et al. reference teaches that the eventual downloaded package "is no bigger or smaller than what is absolutely required by the components and options selected"²⁴, with the word "required" referring to those program components that are *required by the receiving system*, which has no relationship to whether a second data processor meets *requirements of the program* (and therefore nowhere suggesting making this determination prior to downloading the program). The

²³ Suzuki, *supra*, English language abstract.

²⁴ Halpern et al., *supra*, Abstract, lines 19 through 21, cited in Office Action, *supra*, ¶7.

Suzuki et al. reference and the other references provide no teaching regarding this distinction of requirements between the Halpern et al. reference and those of the claim.

Absent the improper hindsight use of his own teachings, Applicant respectfully submits that there is no suggestion to combine the Halpern et al. and Suzuki references, and then modify this combination, in such a manner as to reach the apparatuses claimed in proposed amended claims 23 and 24. No suggestion is provided by the prior art or otherwise to radically alter the system of the Halpern et al. reference to no longer select and download only those software components useful for or desired by a particular destination client system, but instead to operate a first data processor to determine whether platform requirements associated with a program are met by a second data processor and, in response to this determination, then downloading the program to that second data processor.

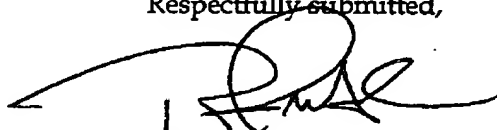
The important advantages provided by the apparatus of claims 23, 24, and the claims dependent on claim 24, such advantages corresponding to those discussed above relative to proposed amended claim 1, further support the patentability of these claims.

For these reasons, Applicant respectfully submits that, upon entry of this amendment, amended claim 23, amended claim 24 and its dependent claims will be patentably distinct over the applied references.

The prior art cited by the Examiner as pertinent, but not applied, has been considered but is not felt to come within the scope of the claims now in this case.

For these reasons, Applicant respectfully submits that, upon entry of this amendment, all claims remaining in this case will be in condition for allowance. Entry of this amendment in, and favorable reconsideration of, this application are therefore respectfully requested.

Respectfully submitted,



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37 C.F.R. 1.8

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